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DATE: February 8, 2001

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Name: Dianne E. Maggard

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BOARD OF PATENT
APPEALS &
INTERFERENCES

FEB 13 2001

Client/Matter No.: ISIS 4502

SENDER'S NAME: John W. Caldwell

PAGES TO FOLLOW: 7

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COVER MESSAGE:

Ms. Maggard: As per our conversation of today.

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DOCKET NO.: ISIS-4502

PATENT

BOARD OF PATENT
APPEALS &
INTERFERENCES

FEB 13 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Richard H. Tullis

Serial No.: 08/078,768

Filing Date: June 16, 1993

For: Oligonucleotide Therapeutic Agents and Methods of Making Same

DATE OF DEPOSIT: _____
I HEREBY CERTIFY THAT THIS PAPER IS BEING
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TO THE BOARD OF PATENT APPEALS AND
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TRADEMARKS, WASHINGTON, DC 20231.

TYPED NAME: John W Caldwell
REGISTRATION NO. _____

Board of Patent Appeals and Interferences
Commissioner of Patents and Trademarks
Washington DC 20231

STATEMENT UNDER 37 C.F.R. §3.73(b)

Molecular Biosystems, Inc., a corporation, states that it is:

the assignee of the entire right, title, and interest; or
 an assignee of an undivided part interest

in the patent application/patent identified above by virtue of either:

A. An assignment from the inventor(s) of the patent application/patent identified above.
 1. The assignment was recorded in the Patent and Trademark Office at Reel 3941, Frame 0775. The assignment was again recorded in the Patent and Trademark Office at Reel 4079, Frame 0445 due to a name change of the assignee.

DOCKET NO.: ISIS-4502

- 2 -

PATENT

2. The assignment has not yet been recorded. A copy of the assignment is attached.

OR

B. A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

- i. From: _____ To: _____ The document was recorded in the Patent and Trademark Office at Reel _____, Frame(s) _____, or for which a copy thereof is attached.
- ii. From: _____ To: _____ The document was recorded in the Patent and Trademark Office at Reel _____, Frame(s) _____, or for which a copy thereof is attached.
- iii. From: _____ To: _____ The document was recorded in the Patent and Trademark Office at Reel _____, Frame(s) _____, or for which a copy thereof is attached.

Additional documents in the chain of title are listed on a supplemental sheet.

Copies of assignments or other documents in the chain of title are attached.

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.



Signature

Name: Lloyd A. RowlandTitle: Vice President's General Counsel

Date: Feb. 7, 2001

DOCKET NO.: ISIS-4502

PATENT
#63
6/13/01

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

In reAppeal of:**Examiner: J. Martinell****Richard H. Tullis****Art Unit: 1804****Appeal No. 1998 - 0218****Serial No. 08/078,768****Filed: June 16, 1993****For: Oligonucleotide Therapeutic Agent and Methods of Making Same**

I, John W. Caldwell, Registration No. 28,937 certify that this correspondence is being
facsimile transmitted to the USPTO to the attention of Diane Maggard at 703 302-
6200 on February 8, 2001.

John W. Caldwell
John W. Caldwell, Registration No. 28,937

FEB 13
BOARD OF PATENT
APPEALS &
INTERFERENCES

**REQUEST FOR SUSPENSION OF APPEAL
IN ORDER TO SUBMIT MATERIALS FOR
CONSIDERATION BY THE EXAMINER**

Assistant Commissioner
for Patents
Washington, D.C. 20231

Sir:

This appeal is presently scheduled for hearing on February 20, 2001 in accordance with the Notice of Hearing appended hereto. Effective ownership of this application has recently changed and a new Power of Attorney in favor of the undersigned, copy attached, has just been executed. It is requested that the hearing be postponed and the application be redirected to the Examiner for further proceedings.

In particular, applicant wishes to inform the Patent Office of the issuance of U.S. Patent 5,919,619, issued from a continuation application to the present application filed May 31, 1995. In that patent prosecution, the Examiner and applicant reached agreement as to thirteen claims. Except for a single limitation, claim 1 of the 619 patent is identical to claim 1 now on appeal. Claim 1 of

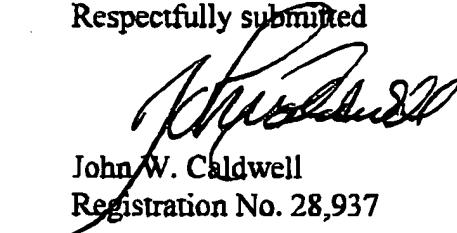
DOCKET NO.: ISIS-4502**PATENT**

the 619 Patent is limited to methods of downregulated protein by antisense oligonucleotides in cell cultures, while the claims on appeal do not have the cell culture limitation. The Examiner's consideration of this issue will doubtless lead to simplification and possibly elimination of the issues before the board. This is because many of the objective bases for the extant §112 rejection are applicable to uses of the invention under both *in vivo* and *in vitro* conditions. Consistency of examination requires reconsideration by the Examiner. A fuller discussion of the points and authorities appertaining to this issue will be submitted following remand.

Applicants also wish the Examiner to be aware of an unfavorable ruling by the European Patent Office with regard to a related application before that body. Again, fuller information will be supplied to the Examiner.

Accordingly, it is requested that this Appeal be suspended pending further review by the Examiner. A time period of ninety days should be set for further submissions by Applicant.

Respectfully submitted



John W. Caldwell
Registration No. 28,937

Date: *February 8, 2001*

WOODCOCK WASHBURN KURTZ
MACKIEWICZ & NORRIS LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103
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2155683439
UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

250

Townsend, Townsend,
Khourie & Crew
~~Marker~~
Steiner Street Tower 20th Floor
San Francisco, CA 94105

Appeal No:
Appellant:
Application No:
Hearing Room:
Hearing Docket:
Hearing Date:
Hearing Time:
Location:

Paper No. 57

1998-0218
Richard H. Tullis
08/078,768
B
A
Tuesday, February 20, 2001
9:00 AM
Room 12C07
CRYSTAL GATEWAY 2
1225 Jefferson Davis Highway
Arlington, VA 22292

NOTICE OF HEARING**CONFIRMATION REQUIRED WITHIN TWENTY-ONE DAYS**

Your attention is directed to 37 CFR § 1.194(a). The above identified appeal will be heard by the Board of Patent Appeals and Interferences on the date indicated. Hearings will commence at the time set and as soon as the argument in one appeal is concluded, the succeeding appeal will be taken up. The time allowed for argument is twenty minutes unless additional time is requested and permitted before the argument is commenced.

CONFIRMATION OR WAIVER OF THE HEARING IS REQUIRED.

This form must be completed below and filed with the Board of Patent Appeals and Interferences preferably by facsimile within TWENTY-ONE (21) DAYS from the mailing date of this notice indicating confirmation or waiver of the hearing. A copy of this form may alternatively be filed by mail if facsimile is not available.

Failure to file this form within this time period will be construed as a waiver of the request for oral hearing.

37 CFR § 1.136(a) does not apply.

By order of the Board of Patent Appeals and Interferences

BPAI FAX No:

(703)-308-6200
1108 Off Gaz. Pat. Trademark
Office 15 (Nov. 14, 1989).

See

BPAI Mailing Address:

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COMMISSIONER OF PATENTS AND TRADEMARKS
WASHINGTON, D.C. 20231

Paralegal Specialist
Dianne E. Maggard
(703)-305-4679

MAILED

In all communications relating to this appeal, please identify the appeal by its number.

OCT - 6 2000

CHECK ONE:

HEARING ATTENDANCE CONFIRMED
 HEARING ATTENDANCE WAIVED

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Kenneth A. Weber
Signature of Attorney/Agent/Appellant
Kenneth A. Weber

Date

Registration No 31,677

11/6/00